

Appl. No. : 10/044,304  
Filed : October 25, 2001

**REMARKS**

**Amendments to the Claims**

Applicant respectfully requests entry of the Amendments to the Claims set forth above, in which Claims 1-2 and 4-11 have been cancelled, Claim 3 has been rewritten, and new Claims 12-26 have been added. The changes to Claim 3 and new Claims 12-26 are fully supported in the specification and thus there is no issue of new matter. For the convenience of the Office, references to examples of supporting disclosure for each of the claims are provided below:

Claim 3: Original Claim 3; Figure 1; specification at page 6, line 16; page 7, line 20 continuing to page 8, line 7.

Claims 12: Figure 1; specification at page 6, line 16; page 7, line 20 continuing to page 8, line 7.

Claim 13: Figure 2, specification at page 8, line 19 continuing to page 9, line 3.

Claims 14-18: Original Claims 4-6, specification at page 8, line 8 continuing to page 10, line 18.

Claim 19: Specification at page 8, line 18 continuing to page 9, line 3.

Claim 20: Specification at page 10, line 19 continuing to page 11, line 18.

Claim 21-23: Original Claim 7, specification at page 9, lines 6 continuing to page 10, line 18.

Claim 24: Specification at page 12, line 6.

Claims 25-26: Specification at page 11, line 19 continuing to page 12, line 6; page 7, line 20 continuing to page 8, line 7; and page 9, lines 1-3.

Therefore, since all of the changes to the claims are supported in the specification, Applicant respectfully requests entry of the Amendments to the Claims set forth above. Applicant reserves the right to file divisional and/or continuation applications containing claims directed to all or part of the subject matter described in the instant application, as well as the subject matter of any claims withdrawn, amended or canceled at any time during the prosecution of this application, and thus unclaimed subject matter is not dedicated to the public.

Appl. No. : 10/044,304  
Filed : October 25, 2001

**Election/Restriction**

Applicant hereby affirms the previous telephonic election of Group II, Claims 3-8, without traverse. Accordingly, withdrawn Claims 1-2 and 9-11 have been canceled without prejudice.

**Interview Summary Statement**

Applicant thanks the Office for the courtesies extended to Applicant's representative during the telephonic interview with the Examiner conducted on April 28, 2003. Applicant's representative noted that the Office had taken the position in the aforementioned Office Action that the Information Disclosure Statement filed in this case fails to comply with 37 C.F.R. §1.56(b). Applicant respectfully disagreed with the Office's position. It is Applicant's understanding, based on the telephonic interview with the Examiner, that the Office has considered all of the references cited in the Information Disclosure Statement.

**Information Disclosure Statement**

Applicant acknowledges receipt of the initialed copy of the PTO-1449 form listing references submitted by Applicant in the IDS filed on August 9, 2002. Applicant respectfully requests initialed copies of the PTO-1449 forms listing references submitted by Applicant in the IDS's filed on March 11, 2003, May 5, 2003 and June 3, 2003.

**Drawings**

The Office has objected to the drawings for minor informalities. In response, Applicant has provided in a separate paper filed today a set of formal drawings in which the informalities have been corrected and in which reference no. 103 has been added to Figure 2 to conform with the description at page 8, line 19 continuing to page 9, line 3. In accordance with Office procedure, the formal drawings are filed as separate sheets accompanied by a transmittal letter addressed to the Official Draftsperson. Applicant respectfully requests consideration of the formal drawings and entry of the drawings into the file of this application.

Appl. No. : 10/044,304  
Filed : October 25, 2001

**Claim Rejections - 35 U.S.C. §112**

Claims 4 and 6 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, on the basis that it is unclear as to whether the term “of a patient” defines a limitation since the lens is not previously disclosed specifically as an ophthalmic lens. Applicant respectfully submits that this rejection has been mooted by the cancellation of Claims 4 and 6, and respectfully point out that Claims 3 and 12-24 are directed to an eyeglass lens. Therefore, Applicant respectfully requests reconsideration and withdrawal of this rejection.

**Claim Rejections - 35 U.S.C. §102(b)**

Claims 3, 4 and 7 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Guilino et al. (U.S. Patent No. 5,148,205). Applicant respectfully submits that, with respect to Claims 4 and 7, this rejection has been mooted by the cancellation of those claims. Applicant respectfully traverses this rejection with respect to Claim 3 and respectfully submits that new Claims 12-26 are neither anticipated by nor obvious in view of Guilino for the reasons set forth below.

The Office states that Guilino discloses a lens having a varying index of refraction along an optical axis of a patient, wherein the refractive index of the lens varies in the hatched region of Guilino figure 2a. However, Applicant respectfully submits that Guilino does not disclose or suggest an eyeglass lens having a varying index of refraction layer with a substantially constant thickness as recited in Claims 3 and 12-24, nor an article of manufacture comprising a stopper and a material having an index of refraction that can be changed by exposure to radiation as recited in Claims 25-26. Applicant respectfully submits that the hatched region of Guilino figure 2a varies substantially in thickness from a value of zero at the center of the lens to a value of “ds” at the edge. Therefore, since Guilino does not disclose or suggest an eyeglass lens or article of manufacture as claimed, Applicant respectfully requests that the Office reconsider and withdraw the rejection of Claims 3, 4 and 7 as being anticipated by Guilino, and refrain from rejecting Claims 12-26 as anticipated or obvious over Guilino.

Claims 3, 4 and 7 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Gupta et al. (U.S. Patent No. 5,080,472). Applicant respectfully submits that, with respect to Claims 4 and 7, this rejection has been mooted by the cancellation of those claims. Applicant

Appl. No. : 10/044,304  
Filed : October 25, 2001

respectfully traverses this rejection with respect to Claim 3 and respectfully submits that new Claims 12-26 are neither anticipated by nor obvious in view of Gupta for the reasons set forth below.

The Office states that Gupta discloses a lens having a first area of constant index of refraction and at least one second area having a varying index of refraction, as indicated in Gupta figures 1 and 2. However, Applicant respectfully submits that Gupta does not disclose or suggest an eyeglass lens having a varying index of refraction layer with a substantially constant thickness as recited in Claims 3 and 12-24, nor an article of manufacture comprising a stopper and a material having an index of refraction that can be changed by exposure to radiation as recited in Claims 25-26. Applicant respectfully submits that Gupta figures 1 and 2 show that the area having a varying index of refraction varies substantially in thickness. Therefore, since Gupta does not disclose or suggest an eyeglass lens or article of manufacture as claimed, Applicant respectfully requests that the Office reconsider and withdraw the rejection of Claims 3, 4 and 7 as being anticipated by Gupta, and refrain from rejecting Claims 12-26 as anticipated or obvious over Gupta.

**Claim Rejections - 35 U.S.C. §103(a)**

Claims 5, 6 and 8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Gupta et al. (U.S. Patent No. 5,080,472) in view of Magnante (U.S. 6,086,204). Applicant respectfully submits that this rejection has been mooted by the cancellation of Claims 5, 6 and 8, and that Claims 3 and 12-26 are neither anticipated nor obvious over Gupta and/or Magnante, each alone or together, for the reasons set forth below.

The Office states that Gupta does not specifically disclose that the Gupta lens corrects higher order aberrations, but that it would have been obvious to one skilled in the art at the time of the invention to vary the refractive index of the Gupta lens to correct for higher order aberrations since Magnante teaches making a contact lens with a varying index of refraction to correct higher order aberrations.

Assuming, *arguendo*, that one of ordinary skill in the art would have been motivated to modify Gupta in the manner suggested by the Office, the resulting lens would not have had a varying index of refraction layer with a substantially constant thickness as recited in Claims 3 and 12-24, nor would it be an article of manufacture comprising a stopper and a material having

an index of refraction that can be changed by exposure to radiation as recited in Claims 25-26. As discussed above, the varying index of refraction areas of the Gupta lenses do not have a substantially constant thickness, and the Gupta lenses do not comprise a stopper and a material having an index of refraction that can be changed by exposure to radiation. These shortcomings would not have been remedied by modifying the Gupta lenses using the methods disclosed by Magnante. The Magnante methods (e.g., diamond point machining, mechanical force thermal molding, photolithography, thin film deposition, and surface chemistry alteration, see columns 15-18), even if applied to the Gupta lenses, would not have resulted in a lens having a varying index of refraction layer with a substantially constant thickness, nor an article of manufacture comprising a stopper and a material having an index of refraction that can be changed by exposure to radiation. In fact, Magnante specifically teaches away from producing a substantially constant thickness by stating:

To modify these existing methods for the purpose of making a lens useful to correct the higher-order aberrations of the human eye will require refinements that allow the deposition of layers **with thicknesses that vary** selectively over the surface of the lens substrate in order to achieve the required  $z'(x,y)$  shape.

Magnante at column 18, lines 29-34 (emphasis added). Therefore, Applicant respectfully requests that the Office reconsider and withdraw the rejection of Claims 5, 6 and 8 as being unpatentable over Gupta in view of Magnante, and refrain from rejecting Claims 3 and 12-26 under 35 U.S.C. § 102(a) as being unpatentable over Gupta in view of Magnante.

#### **Other References**

The Office states that “there are numerous references that read on with the independent claim. For example, Suda et al, Blankenbecler et al, and Futhey et al are cited as reading on with the claimed invention.” Paper No. 8 at 8. Applicant respectfully disagrees, and respectfully submits that the instant claims satisfy the requirements for patentability in view of all of the prior art cited, searched, and considered by the Office, including the references submitted by Applicant in the IDS’s filed on March 11, 2003, May 5, 2003 and June 3, 2003.

Appl. No. : 10/044,304  
Filed : October 25, 2001

**Conclusion**

Applicant respectfully submits that the instant application is in condition for allowance, early notification of which would be appreciated. Should the Examiner disagree, Applicant respectfully requests a telephonic interview to discuss any outstanding issues. The Examiner is respectfully invited to contact Applicant's representative at the telephone number provided below in this regard.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 6/26/03

By: Joseph J. Mallon  
Joseph Mallon  
Registration No. 39,287  
Attorney of Record  
Customer No. 20,995  
(619) 235-8550

S:\DOCS\UOM\UOM-4952.DOC:062603